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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/607,718 | 06/27/2003 | Kevin T. Rowney | 006224.P001X3 | 9417 |

7590 05/01/2009

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| EXAMINER | |
|---|---|
| DAYE, CHELCIE L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2161 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/01/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/607,718 | ROWNEY ET AL. | |
| | Examiner | Art Unit | |
| | CHELCIE DAYE | 2161 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6 and 8-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/18/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This action is issued in response to applicant's amendment filed February 17, 2009.

2. Claims 1-6 and 8-32 are presented. No claim added and claim 7 is cancelled.

3. Claims 1-6 and 8-32 are pending.

4. Applicant's arguments filed February 17, 20096, have been fully considered but they are not persuasive.

### *Information Disclosure Statement*

5. The information disclosure statement (IDS) submitted on 02/18/09 was filed after the mailing date of the application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 20, and 31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite "the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data"; however, the preceding claim limitation requires the abstract data structure to be derived from data elements of pre-selected data. The examiner believes that in order for the system to use the abstract data structure to locate the needed data information (i.e. data elements of pre-selected data), the system must use what is within the abstract data structure which would be the data elements of pre-selected data as opposed to using the abstract data structure without using/considering what is in the abstract data structure. Even though the applicant has provided a citation of what they believe to support the newly added feature of the claim, the examiner still believes the specification does not provide adequate detailed support for such amendment to describe that the indicated pre-selected data has been detected based on the abstract data structure without searching data elements of the pre-selected data, at all. Corrections needed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 20, and 31-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, newly amended claims 1, 20, and 31-32 recite "the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data". The examiner is unclear as to how there is an indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data, when the abstract data structure is derived from the data elements of the pre-selected data (stated within the 1st limitation of the claim). The applicant has cited paragraphs 92-99 of their specification as describing examples of the indication being based on the abstract data structure without searching for the data elements of the pre-selected data. However, the examiner does not agree with the support being found within the stated citations. Even further, the applicant must remember that having negative limitations, which are not clearly pointed out within the description are not acceptable. Specifically, the claims recite the limitation "without searching for the data elements of the pre-selected data". The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re

Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. In re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff 'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter.1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. The specification shall contain a written description of the invention, and of the manner and process of making

and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form. Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. Further corrections are needed.

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**11. Claims 1-3,6,8-15,20-21,24-26, and 31-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw (US Patent No. 5,835,722) filed June 27, 1996, in view of Shannon (US Patent No. 6,233,618) filed March 31, 1998.**

Regarding Claims 1, 20, and 31-32, Bradshaw discloses a method for a client device, comprising:

searching, text contained in a plurality of documents stored on a plurality of data storage media of the client device for an indication that at least a portion of the pre-selected data stored on the server may be contained in the text of the plurality of documents (column 6, lines 5-20 and 40-49; column 7, lines 19-38, Bradshaw);

detecting at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device (column 8, lines 35-58 and column 10, lines 15-30, Bradshaw)[1], the client device being a personal computing device (column 5, lines 37-38, Bradshaw).

Bradshaw does not expressly teach the detection indicating that a user of the client device has caused the portion of the pre-selected data residing on the server to be stored on the client device.

However, Bradshaw does teach the acceptance of a supervisor to "close" the X-Stop Monitoring routine, as a way of stopping the monitoring/blocking of inappropriate (i.e. pre-selected) data (see col.8, lines 11-16 and 54-61). Also, Bradshaw teaches examples of users, and friends of users, receiving inappropriate emails, and thus blocking and sending out messages of cancellation (see col.11, lines 50-67). It would be obvious to one of ordinary skill

in the art at the time of the invention to understand that if the supervisor closes (i.e. deactivates) the X-Stop Monitoring routine, then that would allow for the user to store pre-selected data thus being the cause for the storage onto the client device. Further, examples 4 & 5 discussed above show that it is because of the user that the pre-selected data is stored on the client device due to the fact that it was the user receiving and requesting the information.

Nevertheless, Bradshaw is not as detailed with respect to receiving an abstract data structure derived from data elements of pre-selected data to be protected; the searching being performed locally; the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data; and sending, from the client to the server, a notification of the detection of the portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device. On the other hand, Shannon discloses receiving an abstract data structure derived from data elements of pre-selected data to be protected (column 8, lines 24-67, Shannon)[2]; the searching being performed locally (column 6, lines 28-35; column 9, lines 27-39, Shannon); the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data (column 8, lines 49-67, Shannon); and

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[1] Examiner Notes: Further examples of detecting pre-selected data can be found at column 11, Examples 1 and 2, Bradshaw.

[2] Examiner Notes: Table 3 is a form of an index data structure, which corresponds to the abstract data structure. Also, Shannon further discloses the pre-selected data being stored on a server (see column 6, lines 28-34).

sending, from the client to the server, a notification of the detection of the portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device (column 14, lines 26-48, Shannon)[3]. Bradshaw and Shannon are analogous art because they are from the same field of endeavor of controlling the access of particular data. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Shannon's teachings into the Bradshaw system. A skilled artisan would have been motivated to combine as suggested by Shannon at column 3, lines 46-50 and column 4, lines 33-50, in order to provide a more efficient and up-to-date system for controlling access by client computers to available data dependent upon the content.

Regarding Claim 2, the combination of Bradshaw in view of Shannon, disclose a method further comprising:

upon detecting at least a portion of the pre-selected data, preventing access to the detected data (column 14, lines 37-41, Shannon).

Regarding Claims 3 and 21, the combination of Bradshaw in view of Shannon, disclose a method wherein the text contained in the plurality of documents is searched periodically (columns 9-10, lines 64-67 and 1, respectively, Shannon).

[3] Examiner Notes: More details regarding the server being coupled to the client device via a network can

Regarding Claims 6 and 24, the combination of Bradshaw in view of Shannon, disclose a method further comprising:

receiving instructions defining a scope of a search for the client device from the server (column 6, lines 28-47, Shannon).

Regarding Claims 8 and 25, the combination of Bradshaw in view of Shannon, disclose a method wherein searching text contained in the plurality of documents comprises monitoring one or more specific data operations for presence of at least a portion of the pre-selected data (column 13, lines 23-34, Shannon).

Regarding Claims 9 and 26, the combination of Bradshaw in view of Shannon, disclose a method wherein at least one of the one or more specific data operations is selected from the group consisting of a file-read, a file-write, a file-update (column 9, lines 27-31, Shannon), a read from a removable media device, a write to a removable media device, and access of data stored on any of the plurality of data storage media by a program running on the client device (column 12, lines 24-31, Shannon).

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be found at column 5, lines 6-20 and 45-50, Shannon.

Regarding Claim 10, the combination of Bradshaw in view of Shannon, disclose a method wherein the pre-selected data has a tabular format (column 8, Table 3, Shannon).

Regarding Claim 11, the combination of Bradshaw in view of Shannon, disclose a method wherein the pre-selected data is capable of being re-structured into a tabular format based on relationships among elements of the pre-selected data (column 7, Table 2 and lines 58-64, Shannon).

Regarding Claim 12, the combination of Bradshaw in view of Shannon, disclose a method wherein the pre-selected data is maintained by an organization in at least one of a spreadsheet, a flat file, and a database (column 8, lines 24-30, Shannon).

Regarding Claim 13, the combination of Bradshaw in view of Shannon, disclose a method wherein the pre-selected data is associated with an abstract data structure comprising a tuple-storage structure[4] derived from the pre-selected data (column 8, Table 3, Shannon).

Regarding Claim 14, the combination of Bradshaw in view of Shannon, disclose a method wherein the abstract data structure comprises a plurality of

[4] Examiner Notes: The tuple-storage structure is Table 3 shown with numbered rows.

tuples, each of the plurality of tuples including a row numbers of a data item in a corresponding cell of a tabular structure of the pre-selected data (column 8, Table 3 and lines 49-51, Shannon; wherein the plurality of tuples correspond to the multiple rows and also the rows within Table 3 are numbered which corresponds to the "including row numbers of a tabular structure").

Regarding Claim 15, the combination of Bradshaw in view of Shannon, disclose a method wherein each of the plurality of tuples additionally includes a column number (column 8, lines 57-62, Shannon) and optionally a column type of the data item in the corresponding cell.

**12. Claims 4, 16-19, 22, and 27-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw (US Patent No. 5,835,722) filed June 27, 1996, in view of Shannon (US Patent No. 6,233,618) filed March 31, 1998, and further in view of Brandt (US Patent No. 5,892,905) filed December 23, 1996.**

Regarding Claims 4 and 22, the combination of Bradshaw in view of Shannon, disclose all of the claimed subject matter as stated above. However, the combination of Bradshaw in view of Shannon, are silent with respect to the text contained in the plurality of documents being searched when the client device is disconnected from the network. On the other hand, Brandt discloses the text contained in the plurality of documents being searched when the client

device is disconnected from the network (column 17, lines 46-50, Brandt). Bradshaw, Shannon, and Brandt, are analogous art because they are from the same field of endeavor of access control of networked data. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Brandt's teachings into the Bradshaw and Shannon system. A skilled artisan would have been motivated to combine as suggested by Brandt at column 17, lines 51-55, in order to stay consistent with the maintenance on a system, as well as ensuring reliability without undue disruption.

Regarding Claims 16 and 27, the combination of Bradshaw in view of Shannon, and further in view of Brandt, disclose a method wherein the plurality of data storage media is selected from the group consisting of a main memory ("DRAM"; column 10, lines 8-11, Brandt), a static memory, and a mass storage memory.

Regarding Claims 17 and 28, the combination of Bradshaw in view of Shannon, and further in view of Brandt, disclose a method wherein a plurality of data storage media comprises

one or more volatile storage device (column 5, lines 5-8, Bradshaw); and

one or more persistent storage device (column 10, lines 53-61, Brandt).

Regarding Claims 18 and 29, the combination of Bradshaw in view of Shannon, and further in view of Brandt, disclose a method further comprising detecting use of the pre-selected data by an application[5] running on the client device (column 6, lines 8-15, Shannon).

Regarding Claims 19 and 30, the combination of Bradshaw in view of Shannon, and further in view of Brandt, disclose a method further comprising:

identifying the application using the pre-selected data (column 10, lines 51-59, Shannon); and

reporting the identified application (column 10, lines 59-64, Shannon).

**13. Claims 5 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw (US Patent No. 5,835,722) filed June 27, 1996, in view of Shannon (US Patent No. 6,233,618) filed March 31, 1998, further in view of Brandt (US Patent No. 5,892,905) filed December 23, 1996, and further in view of Dascalu (US Patent No. 5,958,015) filed October 29, 1996.**

Regarding Claims 5 and 23, the combination of Bradshaw in view of Shannon, and further in view of Brandt, disclose a method wherein sending a notification comprises:

[5] Examiner Notes: The application corresponds to a "network device", which has access to the databases and permits data communication (column 5, lines 12-20, Shannon).

upon detecting the pre-selected data, creating a message containing the notification of the detection of the pre-selected data (column 14, lines 42-48, Shannon); and

transmitting the message to the server after the client device is re-connected to the server (column 18, lines 24-30, Brandt). However, the combination of Bradshaw in view of Shannon, and further in view of Brandt, are silent with respect to placing the message in a transmission queue. On the other hand, Dascalu discloses placing the message in a transmission queue (column 4, lines 25-40, Dascalu). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Dascalu's teachings into the Bradshaw, Shannon, and Brandt system. A skilled artisan would have been motivated to combine in order to provide a network device that offers access control at particular levels for easier transmission.

## *Response to Arguments*

**Applicant argues, Bradshaw nor Shannon teach the newly added feature "the detection indicating that a user of the client device has caused the portion of the pre-selected data residing on the server to be stored on the client device".**

Examiner respectfully disagrees. In response to the applicant's new amendment and argument as stated above; the examiner believes that it is understood within the art

and within the Bradshaw reference that due to the actions of the user is what caused the pre-selected data residing on the server to be stored on the client device (col.8, lines 11-16 and 54-61 & col.11, lines 50-67).

## *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHELCIE DAYE whose telephone number is (571) 272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
Patent Examiner
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April 29, 2009

/Apu M Mofiz/
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